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FRANK C. NICHOLAS (33,983)
Name of applicant, assignee or registered representative

/FRANK C. NICHOLAS/
Signature

January 24, 2007
Date of Signature

PATENT
Case No.: AUS920000801US1
(9000/11)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

| | | |
|--------------------------------|---|-------------------------|
| In re patent application of: |) | |
| |) | |
| STEVEN M. FRENCH, ET AL. |) | Examiner: NGUYEN, THANH |
| |) | |
| Serial No.: 09/731,624 |) | |
| |) | |
| Filed: DECEMBER 7, 2000 |) | Group Art Unit: 2144 |
| |) | |
| Title: METHOD AND SYSTEM FOR |) | |
| GENERATING A LIST OF OPERATING |) | |
| SYSTEMS FOR A TARGET DEVICE |) | |

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A holding of abandonment issued December 29, 2006. This notice is erroneous, as Appellants previously timely filed a supplemental appeal brief, on September 26, 2005 and also on November 17, 2005, and filed a request for the status of the application on May 18, 2006.

The Examiner's September 9, 2005 action attempted to reopen prosecution after Appellant's appeal – however, the Examiner asserted no new grounds of rejection, and therefore Appellants opted to maintain their appeal, as was their right under §41.41 of the rules. §41.41 provides that the filing of a reply brief acts as a request that the appeal be maintained.

The attached Exhibit A is a printout of PAIR illustrating that the PTO did in fact receive the brief filed on §41.41 on both September 26, 2005, and again on November 17, 2005. In addition, PAIR clearly notes that the status request (no response was issued) was received on May 18, 2006. Clearly, this matter is not abandoned despite the errors in the status noted by PAIR.

Additionally, were the §41.41 brief noncompliant with the rules in any fashion, the Examiner must notify the Appellant, as mandated by §41.41(b). Since no such notification was issued, Appellant is confident that the brief is fully compliant.

Indeed, Comment 65 to the new rules initiated in the Fall of 2004 specifically addresses the precise situation here – the Examiner's response to the filed Appeal Brief failed to contain any true new grounds of rejection, and Appellants did not wish to reopen prosecution. As Comment 65 notes:

One comment suggests that allowing the examiner to institute a new ground of rejection in the examiner's answer is unfair to the appellant and the examiner should be required to reopen prosecution.

Answer: If the examiner institutes a new ground of rejection in the examiner's answer, then the appellant has two months to either request that prosecution be reopened by filing a reply under § 1.111 or file a reply brief under § 41.41, which would act as a request that the appeal be maintained. Accordingly, although the examiner may in limited situations institute a new ground of rejection on appeal, the appellant has the right to request that prosecution be reopened. An appellant may not wish to have

prosecution reopened if the new ground of rejection is similar to a prior rejection or if the evidence of record is sufficient to address the rejection. Moreover, reopening prosecution may prolong examination without any benefit to the appellant.

Therefore, Appellant asks that the abandonment of this application be withdrawn, and that this matter pass to the Board for a prompt ruling on its appeal of the Examiner's erroneous rejections.

SUMMARY

The Appellants respectfully request withdrawal of the holding of abandonment, maintenance of their appeal, and submit that claims 1-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **January 24, 2007**

Respectfully submitted,
STEVEN M. FRENCH, *et al.*

/FRANK C. NICHOLAS/

CARDINAL LAW GROUP
1603 Orrington Avenue, Suite 2000
Evanston, IL 60201
(847) 905-7111

FRANK C. NICHOLAS,
Registration No. (33,983)
Attorney for Appellants

EXHIBIT A

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09/731,624

Method and system for generating a list of operating systems for a target device



| | | | | |
|------------------------------|--------------------|---------------------|-------------------|--------------------------|
| Application Transaction Data | Image File History | Published Documents | Publication Dates | Address & Attorney/Agent |
|------------------------------|--------------------|---------------------|-------------------|--------------------------|

This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click StartDownload.

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|----------------|---|------------|--------------------------|--------------------------|--------------------------|
| 05-18-2006 | Request for status of Application | 5 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 11-17-2005 | Appeal Brief Filed | 26 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 09-26-2005 | Appeal Brief Filed | 24 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 09-09-2005 | Non-Final Rejection | 12 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 09-09-2005 | List of references cited by examiner | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 09-09-2005 | Search information including classification, databases and other search related notes | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 09-09-2005 | Index of Claims | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-17-2005 | Examiner's search strategy and results | 5 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 06-03-2005 | Appeal Brief Filed | 24 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 04-11-2005 | Notice of Appeal Filed | 2 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 01-14-2005 | Final Rejection | 12 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 01-14-2005 | Index of Claims | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-16-2004 | Fee Worksheet (PTO-06) | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-16-2004 | Fee Worksheet (PTO-06) | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-16-2004 | Amendment - After Non-Final Rejection | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-16-2004 | Claims | 6 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-16-2004 | Applicant Arguments/Remarks Made in an Amendment | 4 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-16-2004 | Transmittal to TC | 2 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 08-06-2004 | Examiner Interview Summary Record (PTOL - 413) | 4 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 05-14-2004 | Non-Final Rejection | 9 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
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| 05-14-2004 | List of References cited by Applicant and considered by examiner | 2 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 04-22-2004 | Examiner's search strategy and results | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 04-20-2004 | Examiner's search strategy and results | 2 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 04-04-2004 | Examiner's search strategy and results | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 12-10-2001 | Information Disclosure Statement (IDS) Filed | 2 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 04-27-2001 | Information Disclosure Statement (IDS) Filed | 2 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| 12-07-2000 | Issue Information, including classification, examiner, name, claim, renewals, etc. | 1 | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |

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|------------|---|----|--------------------------|
| 12-07-2000 | Search information including classification, databases and other search related notes | 1 | <input type="checkbox"/> |
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| 12-07-2000 | Authorization for Extension of Time all replies | 1 | <input type="checkbox"/> |
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| 12-07-2000 | Specification | 15 | <input type="checkbox"/> |
| 12-07-2000 | Claims | 5 | <input type="checkbox"/> |
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| 12-07-2000 | Fee Worksheet (PTO-05) | 1 | <input type="checkbox"/> |
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